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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/774,760

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Kevin J. Mills

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10/11/2006

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EXAMINER

SUN, SCOTT C

ART UNIT

PAPER NUMBER

2182

DATE MAILED: 10/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/774,760

Applicant(s)

MILLS ET AL.

Examiner

Scott Sun

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/11/06, 9/2/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 26-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 26 recites the limitation "the closed-case removable expansion card". There is insufficient antecedent basis for this limitation in the claim. Examiner notes that claim 25 recites "a closed-case removable expansion card" and will assume, for the purpose of continuing prosecution, that claim 26 depends on claim 25 instead of claim

2.

4. Claim(s) 27 and 28 contain the trademark/trade names CompactFlash™ and MultiMediaCard™. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe removable expansion card and removable module.

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Accordingly, the identification/description is indefinite. For the purpose of continuing prosecution, the claims will be interpreted to mean that the removable card/module communicate using industry standard protocols.

5. The following rejections are made based on the examiner's best interpretation of the claims in light of the 35 USC 112 rejections above.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harari et al (US Patent #5,887,145) in view of Hosaka et al (6,408,352).

8. Regarding claim 2, Harari discloses a subscriber-specific communications device (mother/daughter card system 100 shown in figure 1) for use in conjunction with a portable host (host system 200; column 12, lines 46-50) and a removable module (daughter card 20), the portable host having a first slot (slot on host shown in figure 1), the subscriber-specific communications device comprising: a removable expansion card (mother card 10) having a second slot (slot on mother card shown in figure 1) to receive the removable module, removable module interface circuitry (interface 14) to manage data transfers with the removable module; and wherein the first slot and the second slot

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are respectively a first-level slot and a second-level slot (mother card inserts into host, daughter card inserts into mother card), the removable expansion card is a first-level module adapted to couple to the portable host via the first-level slot, the removable module is a second-level module adapted to couple to the first-level module via the second-level slot, and the data transfers include transferring information between the first-level module and the second-level module (details shown in figures 2-4; column 7, line 7-column 8, line 22).

Harari does not disclose explicitly the subscriber information or communication circuitry adapted to have behavior based on the subscriber services information. However, Hosaka discloses a removable module (daughter card 100; figure 1) containing subscriber services information (SIM card; column 5, lines 6-10); and a removable expansion card (mother card 1, figure 1) comprising communication circuitry adapted to have behavior based at least in part on the subscriber services information contained in the removable module (signal conversion between two standards; column 12, lines 4-25). Teachings of Harari and Hosaka are from the same field of removable cards, and specifically of daughter/mother cards.

Therefore, it would have been obvious at the time of invention to combine teachings of Harari and Hosaka by using the signal conversion I/O circuitry in the card system of Harari for the benefit of inter-standard compatibility (column 4, line 17-19)

9. Regarding claim 3, Harari and Hosaka combined disclose the subscriber-specific communications device of claim 2, wherein the removable module is a removable

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memory (flash memory; figure 4) and the removable module interface circuitry includes removable memory adapter circuitry (memory interface 56).

10. Regarding claim 4, Harari and Hosaka combined disclose the subscriber-specific communications device of claim 2, and Harari further discloses I/O adapter circuitry (host interface 54 and communication adaptor 12).

11. Regarding claims 5-12, the various connections that connect to the adaptor circuitry, in absence of persuasive evidence that a particular type of connection is significant, it would have been an obvious matter of choice to one of ordinary skill in the art to utilize any type of connection as long as it performs the intended function of communicating data from the expansion card to a device other than the daughter card. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). This is further evidence by applicant's various claimed embodiments.

12. Regarding claim 13, Harari and Hosaka combined disclose the subscriber-specific communications device of claim 2, and Harari further discloses wherein messages are received and captured by a receiver (antenna or other I/O interface of the portable device, column 6, lines 46-50). Examiner notes that Harari

13. Regarding claim 14, Harari and Hosaka combined disclose the subscriber-specific communications device of claim 13, and Harari further discloses wherein the captured messages are accessible via the portable host (by definition of a portable device)

14. Regarding claim 15, Harari and Hosaka combined disclose the subscriber-specific communications device of claim 14, and Harari further discloses wherein: the

messages include broadcast messages; and the captured messages include captured broadcast messages (by definition of PDA and other wireless portable devices).

15. Regarding claim 16, Harari and Hosaka combined disclose the subscriber-specific communications device of claim 14, and Hosaka further discloses wherein the behavior of the communications circuitry includes filtering out a portion of the captured messages not applicable to a present status of a subscriber. Examiner notes that because the mother card as disclosed by Hosaka performs conversion from and to the daughter card, it would also perform the filtering based on the protocol specified by the daughter card.

16. Claims 17-20 are substantially similar to claims 13-16 above. The same grounds of rejection are applied. Examiner notes that the services include messages.

17. Regarding claim 21, Harari and Hosaka combined disclose the subscriber-specific communications device of claim 2, and Harari further discloses wherein the subscriber services information is for an individual user (column 5, lines 6-10). Examiner notes that subscriber services information by definition is for an individual user, and that Hosaka's daughter card can be a SIM card, or subscriber identity module, used for performing cellular communications).

18. Regarding claim 22, Harari and Hosaka combined disclose the subscriber-specific communications device of claim 2, and Hosaka further discloses wherein the contents of the removable module are used to identify the subscriber services currently associated with an individual (column 5, lines 6-10). Examiner notes that a SIM card contains the subscriber services information.

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19. Regarding claim 23, Harari and Hosaka combined disclose the subscriber-specific communications device of claim 2, and Hosaka further discloses wherein the contents of the removable module are used to determine user access to subscriber services (column 5, lines 6-10; functionality of the SIM card).

20. Regarding claim 24, Harari and Hosaka combined disclose the subscriber-specific communications device of claim 2, and Hosaka further discloses wherein the contents of the removable module are used to selectively enable at least some communications in accordance with subscriber status (functionality of the SIM card).

21. Regarding claim 25, Harari and Hosaka combined disclose the subscriber-specific communications device of claim 2, and Hosaka further discloses wherein: the removable expansion card is a closed-case removable expansion card (shown in figure 1).

22. Regarding claim 26, Harari and Hosaka combined disclose the subscriber-specific communications device of claim 2, and Harari further discloses wherein: the closed-case removable expansion card is compatible for use in slots adapted to at least one of the 16-bit PCMCIA card type and the 32-bit Card Bus card type (column 8, line 24).

23. Regarding claim 27, Harari and Hosaka combined disclose The subscriber-specific communications device of claim 2, and Hosaka further discloses wherein: the removable expansion card is a CompactFlash card (column 1, line 26).

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24. Regarding claim 28, Harari and Hosaka combined disclose The subscriber-specific communications device of claim 2, and Hosaka further discloses wherein the removable module is a MultiMediaCard card (column 1, line 51).

25. Regarding claim 29, Harari and Hosaka combined disclose The subscriber-specific communications device of claim 2, and Hosaka further discloses wherein the removable expansion card further includes an expansion card frame and PCB (figure 1).

26. Regarding claim 30, Harari and Hosaka combined disclose The subscriber-specific communications device of claim 2, and Harari further discloses wherein the portable host is a PDA (column 12, lines 46-50).

27. Regarding claim 31, Harari and Hosaka combined disclose The subscriber-specific communications device of claim 2, and Harari further discloses wherein the portable host is a portable computer (column 12, lines 46-50).

Conclusion

28. Other publications are cited to further show the state of the art with respect to mother/daughter cards. Refer to form 892, "Notice of References Cited", for a complete list of relevant prior arts cited by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Sun whose telephone number is (571) 272-2675.


The examiner can normally be reached on M-F, 10:30am-7pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim N. Huynh can be reached on (571) 272-4147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SS



KIM HUYNH
SUPERVISORY PATENT EXAMINER
10/27/06